

### **REMARKS**

Independent claims 1, 8, 15, 23, 29 and 30 have been amended. Entry of these amended claims and reconsideration of this application in light of these amendments and the following remarks is respectfully requested. Amended claims 1, 8, 15, 23, 29 and 30 have been amended to overcome the 35 U.S.C. §112 rejections and to distinguish over the patents applied in the above-mentioned office action and are allowable for the following reasons.

#### **Claim rejections under 35 U.S.C. §112**

Claims 1-30 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner indicated that these claims were "cumbersome and should be rewritten". The recommendations suggested by the Examiner have been adopted and therefore, these rejections have been overcome.

In addition, the phrase "the web" has been removed from line 8 of claim 8 as required by the Examiner thereby, overcoming the 35 U.S.C. §112 rejection of claims 8-14.

#### **Claim rejections under 35 U.S.C. §103**

Claims 1-30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Guheen (U.S. Patent 6,957,186) (Guheen) and O'Conner (U.S. Patent 5,745,568) (O'Conner). However, this rejection is not applicable to amended independent claims 1, 8, 15, 23, 29 and 30 and their respective dependent claims for the following reasons.

The independent claims include, among other things, linking the solution identifier to a configuration of systems and software, and the configuration being updated to reflect a customer's changing installed solution, whereby the customer may possess multiple such identifiers to reflect multiple installed solutions for providing users of the identifier customized data based upon the identifier and about specific offerings and entitlements available to the customer.

As the PTO recognizes in MPEP §2142:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The examiner clearly cannot establish a *prima facie* case of obviousness in connection with claims 1-30 for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, Guheen and O'Connor, alone, or in combination, do not teach providing users of the identifier *customized data* based upon the identifier and *about specific offerings and entitlements available to the customer*. Emphasis added. For example, Guheen is used for providing asset management and financial information to the *organization* (col. 146 lines 17-26) and to help the *organization* with management support such as hardware maintenance, release testing, procurement, initial installation, system component configuration and software and data distribution (col. 147 lines 12-20). On the other hand, the present invention provides easy access to a customer about product or service offerings and entitlements available to the customer with respect to the customer's specific solution. This can increase sales to the customer about these products and services available to the customer for the customer's specific solution. In addition, Guheen forces the user to piece together products and services (col. 177 lines 42-46) and define the products and services possessed by completing a user profile (col. 239 lines 60-64). On the other hand, the present invention automatically records information about the hardware and software that makes up the customer's solution. Furthermore, the section of O'Connor indicated by the Examiner only deals with hardware identifiers, not software identifiers (Col. 3 lines 11-34).

Therefore, it is impossible to render the subject matter of claims 1-30 as a whole obvious based on any combination of the patents, and the above explicit terms of the statute cannot be met. As a result, the examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claims 1-30, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the Guheen and O'Connor patents cannot be combined and applied to reject claims 1-30 under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he examiner must step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, as described above, Guheen and O'Connor do not teach, or even suggest, the desirability of the combination because neither teaches or suggests providing users of the identifier customized data based upon the identifier and about specific offerings and entitlements available to the customer.

Thus, neither of these patents provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claims 1-30.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claims 1-30. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claims 1-30, and the rejection under 35 U.S.C. §103(a) is not applicable.

Amended independent claims 1, 8, 15, 23, 29 and 30 are allowable for the reasons indicated above. Dependent claims 2-7, 9-14, 16-22 and 24-28 depend from, and further limit, independent claims 1, 8, 15 & 23, respectively, in a patentable sense and therefore are allowable as well.

In view of all of the above, the allowance of claims 1-20 is respectfully requested.

**PATENT**

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The examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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